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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,454	10/15/2001	Mark D. Erion	030727.0027.CON1	5123

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EXAMINER

JONES, DAMERON

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 04/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/978,454

Applicant(s)

ERION ET AL.

Examiner

D. L. Jones

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1915 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 168-185 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 168-185 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other:

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### ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of Paper No. 8, filed 1/21/03, wherein 169-179 were amended.

Note: Claims 168-185 are pending.

### RESPONSE TO APPLICANT'S ELECTION

2. Applicant's election of the species of Formula I wherein MH is araC; Z, W, and W' are hydrogen, and V is 4-pyridyl in Paper No. 8, filed 1/21/03, is acknowledged.

Note: The full scope of claims 168-185 has been examined.

### STATUTORY DOUBLE PATENTING

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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4. Claims 163 and 180-185 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 95 and 168-173 of prior U.S. Patent No. 6,312,662 B1. This is a double patenting rejection.

#### OBVIOUSNESS TYPE DOUBLE PATENTING

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 168-179 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 95-130 of U.S. Patent No. 6,312,662 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patented invention encompass those of the instant invention.

## 112 REJECTIONS

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 168-173 and 177-185 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 169-173 and 177-179: The claims as written are ambiguous because Applicant refers to the variable MH and assigns variables to that variable, but there is no variable MH in Formula I. However, there is a variable M attached to the phosphorus in Formula I. Did Applicant intend MH to be M? Please make the appropriate correction(s) in order that one may readily ascertain what is being claimed.

Claim 183: The claim is ambiguous because the variable M in formula I has not been defined. In addition, M (see lines 20 and 21) has not been defined in MPO3H2 and MPO32-. Please make the appropriate correction(s).

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**Note:** The claims were examined as if M is attached to the phosphorus of Formula I via a carbon, oxygen, or nitrogen atom.

**Claim 184:** The claim is ambiguous because the variable M in formula I has not been defined. In addition, M (see lines 15 and 16) has not been defined in  $\text{MPO}_3\text{H}_2$  and  $\text{MPO}_3^{2-}$ . Please make the appropriate correction(s).

**Note:** The claims were examined as if M is attached to the phosphorus of Formula I via a carbon, oxygen, or nitrogen atom.

**Claim 185:** The claim is ambiguous because the variable M in formula I has not been defined. In addition, M (see lines 9 and 10) has not been defined in  $\text{MPO}_3\text{H}_2$  and  $\text{MPO}_3^{2-}$ . Please make the appropriate correction(s).

**Note:** The claims were examined as if M is attached to the phosphorus of Formula I via a carbon, oxygen, or nitrogen atom.

**Claims 168 and 180-182:** The claims as written are confusing because of the proviso that 'V, Z, W, and W' are not all hydrogen'. In particular, the phrase is confusing because Z cannot be hydrogen (see definition of the variable Z).

**COMMENTS/NOTES**

9. Claims 168-185 are distinguished over the prior art of record. However, Applicant MUST address and overcome the double patenting and 112 rejections above. In particular, the claims are distinguished over the cited prior art because the prior art neither anticipates nor renders obvious compounds of formulae I and VIII as set forth in Applicant's invention.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (703) 308-4640. The examiner can normally be reached on Mon.-Fri. (alternate Mon.), 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose' Dees can be reached on (703) 308- 4628. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



D. L. Jones  
Primary Examiner  
Art Unit 1616

March 26, 2003